

REMARKS

Reconsideration of this divisional application in view of the above amendments and following remarks is respectfully requested. Claims 1-65 have been cancelled. Claims 66-68 are new and now pending. No new matter has been added. This divisional application is filed in accordance with 35 U.S.C. 120 and 37 CFR § 1.78.

As way of background, the parent application (*i.e.*, U.S. Application No. 09/715, 830 filed November 17, 2000) received a Notice of Allowance on June 17, 2003 for several important aspects of the present invention; namely, for several different claim sets directed to an electrode assembly. Importantly, and as noted in the specification on, for example, page 1, lines 10-13, the present invention relates to fuel cells and, more specifically to fuel cells, electrode assemblies, and electrodes that comprise silicon substrates and/or sol-gel derived support structures as well as to methods relating thereto. Applicants in this divisional application now seek allowance of a claim set directed to an individual electrode separate and apart from the electrode assembly. In short, Applicants now seek allowance of a sub-combination claim set drawn to an electrode of the previously allowed electrode assembly.

It is well established that a claim need not recite each and every element needed for the practical utilization of the claimed subject matter. *Bendix Corp. v. United States*, 600 F2d. 1364, 1369, 204 USPQ 617, 621 (Ct. C. 1979); *See United States. v. Adams*, 383 US 39, 148 USPQ 479 (1966). *See also Carl Zeiss Stiftung v. Renshawpic*, 945 F2d. 1173, 20 USPQ 2d. 1094 (Fed. Cir. 1991).

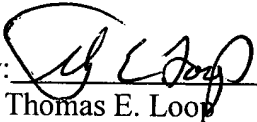
In *Zeiss*, the District Court found claim 3 would be invalid because it claimed a probe but did not recite sufficient structure to enable it to function as a probe. The district court states that the “arbitrary presentation of part of an invention does not constitute a claim of a valid invention.” Thus, the district court essentially ruled that the patentee could not claim a part of his invention separate from the rest of the invention. On review, the Federal Court stated that “[t]his reasoning is legal error” and went on to state:

It is long been held, and we today reaffirm, that it is entirely consistent with the claim definiteness requirement of the second paragraph of section 112 to present “subcombination” claims, drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention. As one of our previous courts stated, “it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter,” as it is “entirely appropriate, and consistent with § 112 to present claims to only [one] aspect. *Bendix Corp. v. United States*, 600 F2d. 1354, 1369, 220 Ct. Cl. 507, 514, 204 USPQ 617, 621 (Ct. Cl. 1979).

In view of the foregoing, allowance of claims 66-68 is earnestly solicited. A good faith effort has been made to place this application in condition for allowance. However, if any further matter requires attention prior to allowance, the Examiner is respectfully requested to contact the undersigned attorney to resolve the same.

Respectfully submitted,

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Enclosures
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